



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|-----------------------|---------------------|------------------|
| 09/501,874 | 02/10/2000 | Stephen Lange Ranzini | 3892-4000 | 4487 |

7590 11/08/2002

MORGAN & FINNEGAN L L P
345 Park Avenue
New York, NY 10154

EXAMINER

ELISCA, PIERRE E

| ART UNIT | PAPER NUMBER |
|----------|--------------|
| 3621 | 15 |

DATE MAILED: 11/08/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

| | |
|-------------------------------|--|
| Application No. 09/501,874 | Applicant(s) Ranzini Stephen Lange et al. |
| Examiner Pierre E. Elisca | Art Unit 3621 |



— The MAILING DATE of this communication appears on the cover sheet with the correspondence address —

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE THREE MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on Aug 12, 2002
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.
- 4) Claim(s) 1-187 and 189 is/are pending in the application.
- 4a) Of the above, claim(s) none is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-187 and 189 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) The proposed drawing correction filed on _____ is: a) approved b) disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) All b) Some* c) None of:
1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. _____.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- *See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) The translation of the foreign language provisional application has been received.
- 15) Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) Notice of References Cited (PTO-892) 4) Interview Summary (PTO-413) Paper No(s). _____
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) Notice of Informal Patent Application (PTO-152)
- 3) Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 6) Other: _____

Art Unit: 3621

DETAILED ACTION

1. This Office action is in response to Applicant's amendment filed on 8/12/2002.

2. Claims 1-187 are remained, claim 188 is canceled and claim 189 is added.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1-15, 19-27, 55-61, 73-81, 100-112, 121, 122, 126, 128, 129, 130, 140-149, 155-159, 162-164, 172-174, 177-179, 180-182 and 189 are rejected under 35 U.S.C. 102 (b) as being anticipated by Bocinsky (U.S. Pat. No. 5,371,797).

As per claims 1, 2, 4, 5, 8-15, 19, 20, 22, 23, 26, 27, 55, 56, 58, 59, 121, 122, 129, 130, 140- 144, 162, 163, 164 and 189 Bocinsky discloses a secure electronics funds or other financial transaction system that provides substantially equivalent security to that obtained by the use of secure point of sale terminals which is equivalent to Applicant's claimed invention wherein said: a method for securely transferring electronic funds, comprising;

Art Unit: 3621

- a) assigning at least one security attribute to a digital rights management container containing a digital representation of money, wherein the at least one security attribute precludes unauthorized access to the container containing the digital representation of money (see.,fig 2, elements 30 and 36, abstract, col 11, lines 3-34, col 12, lines 4-34);
- b) transmitting the container containing a digital representation of money to a recipient (see., abstract, lines 6-26, col 6, lines 6-67). Please note that the security attribute is interpreted as the customer security identification such as PIN number that also includes encryption key, password and so, for monitoring or authorizing data passing from a conventional network or for protecting unauthorized access .

As per claims 3, 21 and 57, Bocinsky discloses the claimed method, wherein the at least one security attribute is the requirement that a recipient of the container containing a digital representation of money enter password, social security number, employee identification number or personal identification number (see., col 4, lines 36-59)

As per claims 6, 24 and 60, Bocinsky discloses the claimed method, wherein the at least one security attribute is the requirement that a recipient of the container containing digital representation of money prove they are the intended recipient through use of a random number generator card or smart card (see., col 5, lines 23-39).

Art Unit: 3621

As per claims 7, 25 and 61, Bocinsky discloses the claimed method, wherein the at least one security attribute is the requirement that a recipient of the container containing a digital representation of money prove they are the intended recipient through biometric scan comprised of a retina scan, fingerprint, voiceprint (see., col 18, lines 48-68).

Claims 73-81, 126, 145-149, 172, 173 and 174 are system's claims that contain the same limitation as claims 1-18, and claim 73, therefore are rejected by the same rationale.

Claim 100-108, 128, 155-159, 177, 178 and 179 are system's claims that contain the same limitation as claims 1-18, therefore are rejected by the same rationale.

Claims 109-112, 180, 181 and 182, contains the same limitation as claim 1, therefore are rejected by the same rationale.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Art Unit: 3621

7. Claims 62- 72, 113-120, 125, 170, 171 and 183-187 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bocinsky, Jr. (U.S. Pat. No. 5,371,797).

As per claims 62-72, 113-120, 125, 170, 171, 183, 184, 185, 186 and 187 Bocinsky substantially discloses the claimed limitations as stated above in claims 1 and 13, but he fails to specifically disclose the step of confirming the transfer upon receiving an electronic mail message. However, Examiner hereby takes Official Notice that electronic mail is notoriously well-known in the art. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the electronic funds transfer of Bocinsky by including an electronic mail upon receiving the money transfer because electronic mail is an object of the internet.

Claim Rejections - 35 USC § 103

8. **The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:**

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. **Claims 16-18, 28-54, 82-99, 123, 124, 127, 131-139, 150-154, 160, 161, 165-169, 175 and 176 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bocinsky, Jr. (U.S. Pat. No. 5,371,797).**

Art Unit: 3621

As per claims 16-18, 28-54, 82-99, 123, 124, 127, 131-139, 150-154, 160, 161, 165-169, 175 and 176, Bocinsky substantially discloses the claimed limitations as stated above in claims 1 and 13, but he fails to specifically disclose the step of confirming the transfer upon receiving an electronic mail message. However, Examiner hereby takes Official Notice that electronic mail is notoriously well-known in the art. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the electronic funds transfer of Bocinsky by including an electronic mail upon receiving the money transfer because electronic mail is an object of the internet.

Response to Arguments

10. Applicant's arguments filed 08/12/2002 have been fully considered but they are not persuasive.

REMARKS

11. In response to claims 1-187, Applicant argues that Bocinsky does not teach or suggest:

- a. “electronic funds transfer” involves any computer file containing a digital representation of money. However, the Examiner respectfully disagrees as this limitation is disclosed by Bocinsky in col 11, lines 3-34, col 12, lines 4-34, fig 2, elements 30 and 36, specifically wherein it is stated that a secure electronic funds or other financial transaction that provides substantially equivalent security to obtained by the use of secure point of sale terminals such as automatic teller machines (automatic

Art Unit: 3621

teller or file containing digital representation of money in the abstract, lines 1-7, and also col 4, lines 36-59 discloses the steps of requiring a recipient of the file containing a digital representation of money enter password, social security number, the social security number taught by Bocinsky performs the same function as Applicant's claimed invention, and the PIN number is considered as a password). As the Examiner stated in the Office action mailed on 3/27/2001, page 6, Bocinsky discloses electronic funds transfer, and therefore it would have been obvious to one of ordinary skill in the art to realize that electronic mail is an object in the internet.

b. "Has at least one security attribute which precludes unauthorized access". However, the examiner respectfully disagrees because Bocinsky discloses an electronic funds transaction see., abstract, lines 1-7, please note that the security attribute is interpreted as the customer security identification such as PIN number that also includes encryption key, password and so for monitoring or authorizing data passing from a conventional network or for protecting unauthorized access . Furthermore, Applicant should duly note that digital rights management container is readable as a file container or database.

CONCLUSION

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication from the examiner should be directed to Pierre Eddy Elisca at (703) 305-3987. The examiner can normally be reached on Tuesday to Friday from 6:30AM. to 5:00PM.

Art Unit: 3621

13. If any attempt to reach the examiner by telephone is unsuccessful, the examiner's supervisor, James Trammell can be reached on (703) 305-9769.

Any response to this action should be mailed to:

Commissioner of patents and Trademarks

Washington, D.C. 20231

or faxed to:

(703) 308-9051, (for formal communications intended for entry)

OR:

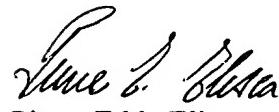
(703) 305-9724 (for informal or draft communications, pleased label

“PROPOSED” or “DRAFT”)

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington. VA., Sixth floor (receptionist).

The Official Fax Number For TC-3600 is:

(703) 305-7687



Pierre Eddy Elisca

Patent Examiner

November 07, 2002